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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/712,020

11/14/2003

Marni Lynn Hurwitz

0200-4

8389

25901

7590

04/17/2007

ERNEST D. BUFF

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EXAMINER

LEWIS, KIM M

ART UNIT

PAPER NUMBER

3772

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/712,020

Applicant(s)

HURWITZ, MARNI LYNN

Examiner

Kim M. Lewis

Art Unit

3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Detailed Action</u> |

DETAILED ACTION

This application has been transferred to Primary Examiner Kim M. Lewis, AU 3772.

Response to Amendment

1. The amendment filed on 10/2/06 has been received and made of record. As requested claim 2 has been amended. Claims 1-3 are pending in the instant application.
2. Claims 1-3 are pending in the instant application.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,887,437 ("Maxim").

As regards claims 1 and 3, Maxim discloses a self-adhering cold pack that anticipates applicant's invention. More specifically, as can be seen from Fig. 7, Maxim discloses a bandage (210) providing a cooling effect to a user, comprising: a flexible and leak proof cold pack container having a first end and a second end, a first bandage support member integrally attached to the first end of said cold pack container, a second bandage support member integrally attached to the second end of said cold pack container, at least one chemical agent (225) and at least one solution (223) collectively disposed within said cold pack container, which, when mixed, undergo an endothermic reaction, rupturable means (217) for separating said agent and said solution within at least one chamber within said cold pack container of said bandage, at least one portion of said separating means being easily broken or ruptured so that said agent and said solution may be mixed, a first skin-adhesive portion (34) located on said first bandage support member for affixing the bandage to the body of said user, and a second skin-adhesive portion (34) located on said second bandage support member for affixing the bandage to the body of said user (col. 4, line 43-col. 5, line12).

Maxim fails to teach that the device or a portion of the device that comes in contact with the skin of a user is sterile. The examiner contends that it would have been *prima facie* obvious to one having ordinary skill in the art to sterilize the device of Maxim in order to prevent bacteria from contaminating the skin of the user.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maxim in view of U.S. Patent No. 5,431,622 ("Pyrozyk et al.") and U.S. Patent No. 3,900,027 ("Keedwell").

As regards claim 2, Maxim fails to teach a sterile portion associated with at least one antibiotic, anesthetic, antipyretic or a burn medicament.

Pyrozyk et al. disclose a cooling bandage having an inherently sterile absorbent portion. Pyrozyk fails to disclose that the absorbent portion may be associated with at least one of an antibiotic, an anesthetic, an antipyretic, and a burn medicament. Keedwell, however, discloses an absorbent pad having thereon an antibiotic (col. 4, lines 19-22) for the inherent purpose of applying therapy to a user.

In view of Keedwell and Pyrozyk et al., it would have been obvious to one having ordinary skill in the art to provide the device of Maxim with an absorbent pad having an antibiotic thereon in order to apply both a medicament and cold therapy to a user.

Response to Arguments

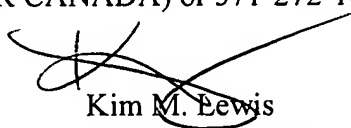
7. Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is (571) 272-4796. The examiner can normally be reached on Monday to Friday, from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco, can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3772

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Kim M. Lewis
Primary Examiner
Art Unit 3772

kml
April 16, 2007